

REMARKS

1. Status of the Claims

Claims 1-14 stand pending and subject to restriction.

2. Response to Restriction

The Office restricted claims 1-14 in to one of the following groups:

Group I, claims 1-4 and 10-12, drawn to a compound and a compound precursor of formula (I); or

Group II, claims 5-6 and 13-14, drawn to a method of producing a compound of formula (I); or

Group III, claims 7-8, drawn to a radiolabeled inhibitor of glutamate transporter activity comprising a compound of formula (I); or

Group IV, claim 9, drawn to a method for examining distribution and/or expression of glutamate transporter and/or glutamate uptake level in a biological sample.

Applicants elect with traverse the claims of **Group I** (*i.e.*, claims 1-4 and 10-12).

Applicants further elect with traverse and for search purposes only the following species: (2S, 3S)-3-{3-(4-[¹²⁵I]benzylbenzoylamino)benzyloxy}aspartate, which is depicted as compound (7) at page 11 of the specification. The species is believed to read upon that is, X is ¹²⁵I and R¹ and R² are hydrogen. Claims 1 and 2 read on the elected species.

3. Traversal

Applicants traverse the restriction and election for the following reasons.

3.1 Unity was found during examination of the PCT Application.

Applicants note that unity of invention was found in the parent PCT application. Additionally, unity was found despite the fact that the same reference as now asserted by the Office was identified during examination by the International Search Authority (ISA). Thus, the ISA found no burden to search all the claims.

When unity is found in the PCT application, there is an *increased burden* above the already “*serious burden*” in evincing why a restriction requirement is necessary. *See* Anthony

Caputa, "Two Be or Not To Be: or Divide and Conquer: or A Case Divided Cannot Stand: Principles in Restriction Practice TC 1600," presented August 2004 to the Customer Partnership Meeting (Attached).

Applicants note that burden, let alone serious burden, went entirely unaddressed in the Restriction Requirement. Therefore, the restriction requirement is improper and should be reconsidered. *See* T. Caputa and M.P.E.P. §§ 803.02, 806.04(a), 806.04(i), 808.01(a) and 808.02. Additionally, as stated by Examiner Caputa, "[i]f the inventions, now being restricted, were searched and examined together in either the current application or a parent, it will be difficult to justify the assertion of burden." T. Caputa, at page 6. Despite the difficulty to justify any burden, burden went completely unaddressed. The restriction should be duly reconsidered and withdrawn.

3.2 The Office cannot limit the scope of the claimed invention to compounds that fall within the same class and subclass as the elected species.

The Office cannot raise an objection of lack of unity of invention merely because the inventions claimed are classified in separate classification groups. PCT Rule 13.2; PCT International Search and Preliminary Examination Guidelines, revised March 25, 2004 ("Guidelines"), ¶ 10.05. For this reason, the Office cannot limit the scope of Applicants' invention to only those compounds that fall within the same class and subclass as the elected compound. *See* Office Action, page 3. Applicants accordingly request rejoinder and consideration of all the species encompassed by the claims, upon an indication that the elected species defines a special technical feature that defines a contribution over the prior art.

3.3 The Office must apply WO 03/000698 in an art rejection under 35 U.S.C. §§ 102 and/or 103 to preserve Applicants' right to rejoinder under the PCT.

MPEP § 1893.03(d) states *inter alia*:

If an examiner (1) determines that the claims lack unity of invention and (2) requires election of a single invention, when all of the claims drawn to the elected invention are allowable (i.e., meet the requirements of 35 U.S.C. 101, 102, 103 and 112), the nonelected invention(s) should be considered for rejoinder.

Accordingly, to preserve Applicants' rights to rejoinder under the PCT, the Examiner must examine the elected claims for compliance with the requirements of 35 U.S.C. §§ 102 and 103. The Office alleges that the claims do not define a contribution over WO 03/000698. The Office cannot fulfill its obligations under the PCT without using WO 03/000698 in a rejection under 35 U.S.C. §§ 102 and/or 103.

3.3 Rejoinder

Applicants note that the certain claims will be subject to rejoinder should the elected claims be found allowable. Pursuant to 37 C.F.R. § 1.475(b)(3), at least Groups II and IV are eligible for rejoinder.

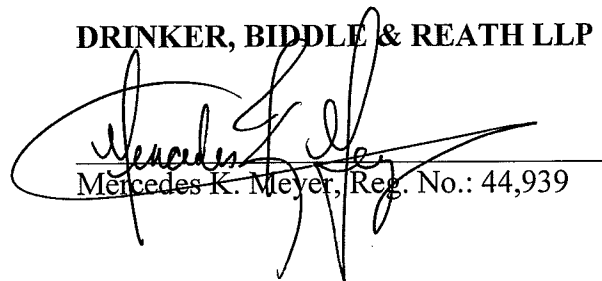
CONCLUSION

Applicants respectfully submit that in light of the above arguments, the restriction and election should be reconsidered and withdrawn. If there are any fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0573. Additionally, if there are any overpayments, please remit the difference to the same Deposit Account Number.

Should the Examiner have any outstanding issues after consideration of this response, she is invited to contact Applicants' undersigned representative to expedite prosecution.

Respectfully submitted,

DRINKER, BIDDLE & REATH LLP



Mercedes K. Meyer, Reg. No.: 44,939

Dated: June 4, 2009

CUSTOMER NO. 55694
DRINKER, BIDDLE & REATH LLP
1500 K Street, N.W., Suite 1100
Washington, D.C. 20005-1209
Tel: (202) 842-8800; Fax: (202) 204-0289